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| GARDERE WYNNE SEWELL LLP INTELLECTUAL PROPERTY SECTION 3000 THANKSGIVING TOWER 1601 ELM ST DALLAS, TX 75201-4761 | | | ZIMMERMAN, JOSHUA D | |
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| | | | 2854 | |

DATE MAILED: 10/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/315,796

Applicant(s)

DAVIS ET AL.

Examiner

Joshua D. Zimmerman

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30, 32-41, 58, 82-84, 154, 156, 158 and 161-164 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5, 12-14, 39-41 and 82-84 is/are allowed.
- 6) ☒ Claim(s) 6-11, 15-30, 32-38, 58, 154, 156, 158 and 161-164 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 10, 44 - 47, and 153 are rejected under 35 U.S.C. 102(e) as being anticipated by Hartung et al. (US 5,630,363).

With respect to claim 10, Hartung et al. teach a plurality of successive printing stations, one of said stations comprising a first flexographic printing station (16, column 6 lines 4 - 9), a downstream second flexographic printing station (16, column 6 lines 4 - 9), and at least one of the successive stations comprising an offset lithographic printing station (12 - 15). The offset station being "successive" is interpreted as being successive to both the first and second flexographic stations. The recitations of the flexographic station printing an "image" or the lithographic station printing "over" the image are merely an intended use of the apparatus and do not structurally limit the flexographic and lithographic stations. Furthermore, the flexographic and lithographic stations of Hartung et al. are capable of printing a first "image" and printing "over" the first image, respectively.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 6 - 9, 11, 15 - 18, 20 - 23, 25 - 28, 58, 161, and 162 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartung et al. in view of Bird (US 4,841,903).

With respect to claim 6, Hartung et al. teach a plurality of successive stations comprising a first flexographic printing station (16, see column 6 lines 4 - 9), a suspended metallic material (column 5 lines 2 - 10), and an offset lithographic station (12-15) downstream of the flexographic station. Hartung et al. do not teach the flexographic printing station being offset or a dryer disposed downstream of the flexographic station. Bird teaches an offset flexographic printing station (12, column 5 lines 13 - 18, 40 - 44, column 6 lines 6 - 20) and a dryer (25a, column 3 lines 12 - 25, column 5 lines 51 - 67) disposed downstream of the offset flexographic station. It would have been obvious to one of ordinary skill in the art to provide the apparatus of Hartung et al. with an offset flexographic printing station in view of Bird so as to more easily convert an offset lithographic station to an offset flexographic station and to dry the first volatile printing/coating before subsequent operations to eliminate smearing of the printing/coating.

With respect to claims 7 and 8 it would have been obvious to one of ordinary skill in the art to provide the metallic particles of Hartung et al. (column 5 lines 2 -10) with uniform or nonuniform sizes to achieve the desired optical effect.

With respect to claims 9 and 11 note the plate cylinder (20.1), flexographic plate (column 3 lines 10 - 11), impression cylinder (18.1), and anilox roller (21) of Hartung et al. and the blanket cylinder (23a) of Bird.

With respect to claim 15 Hartung et al. teach a first flexographic station (56) having an impression cylinder (18.1), a first lithographic station (51), flexographic ink providing means (21, 32) at the first flexographic station, a second lithographic station (52-55), and a second flexographic station (57). Hartung et al. do not teach the first flexographic station comprising a blanket cylinder. Bird teaches a flexographic station (12) comprising a blanket cylinder (23a). It would have been obvious to one of ordinary skill in the art to provide the apparatus of Hartung et al. with an offset flexographic printing station in view of Bird so as to more easily convert an offset lithographic station to an offset flexographic station.

With respect to claim 16 note the plate cylinder (20.1), flexographic plate (column 4 lines 10 - 11), and anilox roller (21) of Hartung et al.

With respect to claim 17 Hartung et al. teach a first flexographic station (56, 16 - see column 6 lines 4 - 9) having a plate cylinder (20.1), an anilox roller (21), and an impression cylinder (18.1), a succeeding lithographic station (51-55, 11-15), and a second flexographic station (57, 17 - See column 6 lines 4 - 9). Although Hartung et al. do not specifically teach the flexographic plate having an "image," the broad recitation of

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an image would not appear to distinguish from a spot coating plate as such a plate would have certain areas in relief compared to other areas. Moreover, Hartung et al. repeatedly disclose that the flexographic stations are "printing/lacquering units" implying that the stations could provide a lacquer or print "images" and that the units print with "pigmented inks" (column 2 lines 44 - 46) or metallic inks (column 5 lines 2 - 10). In view of these teachings, it would have been obvious to one of ordinary skill in the art to print images with the pigmented or metallic inks of Hartung et al. since uniform coatings of pigmented or metallic inks would be wasteful and unappealing. Hartung et al. do not teach the first flexographic station comprising a blanket cylinder. Bird teaches a flexographic station (12) comprising a blanket cylinder (23a). It would have been obvious to one of ordinary skill in the art to provide the apparatus of Hartung et al. with an offset flexographic printing station in view of Bird so as to more easily convert an offset lithographic station to an offset flexographic station.

With respect to claim 18 note the lithographic stations (11-15) for printing lithographic inks.

With respect to claim 20 Hartung et al. do not teach an air dryer. Bird teaches an air dryer (26a) adjacent the impression cylinder (24a). See column 5 lines 23 - 45 of Bird. It would have been obvious to one of ordinary skill in the art to provide the apparatus of Hartung et al. with an air drier in view of Bird so as to adequately dry the flexographic ink before subsequent printing.

With respect to claims 21 and 22 halftone plates are widely conventional in the art to provide the desired shading.

With respect to claim 23 see column 1 line 8 of Hartung et al.

With respect to claims 25 - 28 note the comments above with respect to claims 7 and 8.

With respect to claim 58 Hartung et al. teach a first flexographic station (56, 16) having a plate cylinder (21), a flexographic plate (column 4 lines 10 - 11), a flexographic ink supply and an anilox roller (21) and at least one subsequent lithographic station (11-15, 51-55). Hartung et al. do not teach the first flexographic station comprising a blanket cylinder. Bird teaches a flexographic station (12) comprising a blanket cylinder (23a). It would have been obvious to one of ordinary skill in the art to provide the apparatus of Hartung et al. with an offset flexographic printing station in view of Bird so as to more easily convert an offset lithographic station to an offset flexographic station.

With respect to claim 161, Hartung et al. teach a first flexographic station (56, 16) followed by a first lithographic station (12-15, 51-55). Hartung et al. do not teach a dryer disposed between the stations. Bird teaches a dryer (25+ column 3 lines 12 - 25, column 5 lines 51 - 67) disposed downstream of a flexographic station. It would have been obvious to one of ordinary skill in the art to provide the apparatus of Hartung et al. with a dryer in view of Bird so as to adequately dry the flexographic ink before subsequent printing.

With respect to claim 162 note the at least one further lithographic printing station (12-15, 52-55) of Hartung et al.

3. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hartung et al. in view of Bird as applied to the claims above, and further in view of Sharp (US 4,403,550).

Hartung et al. do not teach waterless inks. Sharp teaches the advantages of waterless lithographic inks. See column 2 line 66+ of Sharp. It would have been obvious to one of ordinary skill in the art to provide the apparatus of Hartung et al., as modified by Bird, with a waterless ink in view of Sharp so as to provide higher printing quality.

4. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hartung et al. in view of Bird as applied to the claims above, and further in view of Schumacher et al. (US 5,079,044). Hartung et al. do not teach printing an encapsulated essence. Schumacher et al. teach printing an encapsulated essence. See column 1 lines 29 - 31 of Schumacher et al., for example. It would have been obvious to one of ordinary skill in the art to provide the apparatus of Hartung et al., as modified by Bird, with an encapsulated essence in view of Schumacher so as to obtain a scratch-and-sniff printed substrate.

5. Claims 29, 33, 38, 156, and 157 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartung et al. in view of Pantone.

With respect to claims 29 and 38, Hartung et al. teach printing with a flexographic ink (column 2 lines 44 - 46, column 3 lines 9 - 12, column 5 lines 2 - 10) on a substrate at a first flexographic station (56 or 16, see column 6 lines 4- 9), transferring the substrate to a lithographic station (51 - 55 or 11 - 15), printing colored ink

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images at a subsequent lithographic printing station (51-55 or 12-15), and coating the substrate at a second flexographic station (17 or 57). Hartung et al. do not explicitly teach that the lithographic station prints on top of a flexographic image. Note that Hartung et al. repeatedly disclose that the flexographic stations are "printing/lacquering units" implying that the stations could provide a lacquer or print "images" and that the units print with "pigmented inks" (column 2 lines 44 - 46) or metallic inks (column 5 lines 2 - 10). Nevertheless, Pantone teaches that process (i.e. lithographic) color images should be printed both on top of and under metallic ink images to achieve the desired effect. See the entire document of Pantone. It would have been obvious to one of ordinary skill in the art to provide the method of Hartung et al. with the step of printing colored images on top of the metallic flexographic image in view of Pantone so as to provide the desired color and metallic effect to the image.

With respect to claim 33 conventional oleophilic lithographic inks are solvent based.

With respect to claim 156 Hartung et al. teach printing an image at a first lithographic station (11), transferring the substrate to a first flexographic station (16, see column 6 lines 4 - 9), printing an image at a second lithographic station (e.g. 12), and then transferring the substrate to a second flexographic station (16, see column 6 lines 4 - 9). Hartung et al. do not specifically teach printing an image at the first and second flexographic stations. Pantone teaches that process color images should be printed both on top of and under metallic ink images to achieve the desired effect. See the entire document of Pantone. It would have been obvious to one of ordinary skill in the

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art to provide the method of Hartung et al. with the step of printing colored images on top of the metallic flexographic image in view of Pantone so as to provide the desired color and metallic effect to the image.

6. Claims 17, 18, 20 - 23, 25 - 28, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartung et al. in view of Pantone as applied to claims 29, 33, 38, 156 above, and further in view of Bird.

With respect to claims 17, 18, 20 - 23, and 25 - 28 note the comments above with respect to Hartung et al. and Bird. Pantone teaches that process color images should be printed both on top of and under metallic ink images to achieve the desired effect.

With respect to claim 30 Hartung et al. do not teach immediately drying the flexographic ink. Bird teaches drying flexographic inks after printing. Note the comments above with respect to Bird. It would have been obvious to one of ordinary skill in the art to provide the method of Hartung et al. with the step of printing a flexographic metallic in view of Pantone so as to provide the desired color and metallic effect to the image and with a drier in view of Bird so as to adequately dry the flexographic ink before subsequent printing.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hartung et al. in view of Pantone as applied to claims 29, 33, 38, 156 above, and further in view of Sharp. Hartung et al. do not teach using waterless lithographic ink.

Sharp teaches the advantages of waterless lithographic inks. See column 2 line 66+ of Sharp. It would have been obvious to one of ordinary skill in the art to provide the

method of Hartung et al., as modified by Pantone, with a waterless ink in view of Sharp so as to provide higher printing quality.

7. Claims 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartung et al. in view of Pantone as applied to claims 29, 22, 38, 156 above, and further in view of Schumacher et al. Hartung et al. do not teach printing an encapsulated essence. Schumacher et al. teach printing an encapsulated essence. See column 1 lines 29 - 31 of Schumacher et al., for example. It would have been obvious to one of ordinary skill in the art to provide the method of Hartung et al., as modified by Pantone, with an encapsulated essence in view Schumacher so as to obtain a scratch-and-sniff printed substrate.

With respect to claim 35 Hartung et al. teach an aqueous coating (17, 57).

8. Claims 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hartung et al. in view of Pantone and Schumacher et al. as applied to claims 34 and 35 above, and further in view of Bird. Hartung et al. do not teach UV curing the coating. Bird teaches UV curing a coating. See column 6 lines 1 - 5 of Bird, for example. It would have been obvious to one of ordinary skill in the art to provide the method of Hartung et al., as modified by Pantone and Schumacher et 2., with the step of UV curing the coating in view of Bird so as to provide a faster curing and more durable coating.

9. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hartung et al. in view of Pantone, Bird, and Sharp. Hartung et al. teach applying a flexographic ink at a first flexographic station (16), transferring the substrate to a second flexographic station (16, column 6 lines 4 - 9) and applying a second flexographic ink and printing an

ink pattern over the flexographic ink at a subsequent lithographic station (12-15).

Hartung et al. do not specifically teach applying a flexographic pattern, with a blanket cylinder, or printing a waterless ink at the lithographic station. Pantone teaches that process color images should be printed both on top of and under metallic ink images to achieve the desired effect. See the entire document of Pantone. Bird teaches the desirability of providing a convertible flexographic station with a blanket cylinder (23a). Sharp teaches the advantages of waterless lithographic printing. See column 2 line 66+ of Sharp. It would have been obvious to one of ordinary skill in the art to provide the method of Hartung et al. with the steps of flexographic printing metallic ink images in view of Pantone so as to provide the desired color and metallic effect to the image, with a blanket cylinder in the flexographic station in view of Bird so as to more easily convert the lithographic stations to flexographic stations, and use waterless ink in view of Sharp to achieve higher quality images. It is noted that the step of transferring the substrate to a second flexographic station does not preclude the existence of a lithographic station between the first and second flexographic printing stations.

10. Claims 154, 160, 163, and 164 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartung et al. in view of Bird (US 4,939,992) and Rodi (US 5,115,741).

With respect to claim 154 Hartung et al. teach a first flexographic station (56, 16 - see column 6 lines 4 - 9), a first lithographic station (12-15, 51-55), and a second flexographic station (57, 16 - see column 6 lines 4 - 9, 17). Hartung et al. do not teach

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dryers disposed after each of the stations. Bird teaches dryers (25a, 16) disposed downstream of flexographic stations (12, 13). See the abstract of Bird, for example. Rodi teaches providing driers (22) after each lithographic station (3 - 6). It would have been obvious to one of ordinary skill in the art to provide the apparatus of Hartung et al. with driers after each of the flexographic and lithographic stations in view of Bird and Rodi so as prevent smearing of the printed images in subsequent printing stations.

With respect to claim 161 Hartung et al. teach a first lithographic station (11), a first flexographic station (16, column 6 lines 4 - 9), a second lithographic station (12), and a second flexographic station (16 or 17/57). Hartung et al. do not teach driers after each of the printing stations. Bird teaches providing driers (25, 16) after each flexographic station. Rodi teaches providing driers (22) after each lithographic (offset) station (3 2 6). It would have been obvious to one of ordinary skill in the art to provide the apparatus of Hartung et al. with driers after each of the flexographic and lithographic stations in view of Bird and Rodi so as prevent smearing of the printed images in subsequent printing stations.

With respect to claim 163 Hartung et al. do not teach a dryer disposed after the first lithographic station. Rodi teaches providing driers (22) after each lithographic (offset) station (3 - 6). It would have been obvious to one of ordinary skill in the art to provide the apparatus of Hartung et al., as modified by Bird with a dryer after the first lithographic station in view of Rodi so as prevent smearing of the printed images in subsequent printing stations.

With respect to claim 164 note the second flexographic station (17, 57) of Hartung et al.

11. Claim 158 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hartung et al. in view of Bird and Rodi as applied to the claims above, and further in view of Pantone. Hartung et al. teach printing at a first lithographic station (11), at a first flexographic station (16, column 6 lines 4 - 9), at a second lithographic station (12), and at a second flexographic station (16 or 17/57). Hartung et al. do not teach driers after the printing stations or printing an image at the flexographic stations. Bird teaches providing driers (25, 16) after each flexographic station. Rodi teaches providing driers (22) after each lithographic (offset) station (3 - 6). Pantone teaches that process color images should be printed both on top of and under metallic ink images to achieve the desired effect. See the entire document of Pantone. It would have been obvious to one of ordinary skill in the art to provide the apparatus of Hartung et al. with driers after each of the flexographic and lithographic stations in view of Bird and Rodi so as prevent smearing of the printed images in subsequent printing stations and flexographic printing metallic ink images in view of Pantone so as to provide the desired color and metallic effect to the image.

12. Claims 1 - 5, 12 - 14, 39 - 41, 82 - 84 are allowed.

13. Claims 44-48, 153, 157, 159 and 160 have been canceled.

Response to Arguments

14. Since applicants failed to present any new arguments for the prior art rejections, and simply referred to the arguments submitted on September 30, 2005, the arguments of the Final Rejection mailed April 06, 2006 are hereby reiterated and maintained.

15. The declarations of John W. Bird dated December 11, 1999, Jesse Speight Williamson and Gary Doughty filed on September 26, 2000, Steve M. Garner filed on April 7, 2000, the Joint Declaration filed on July 7, 2000, and the Joint Declaration filed on August 11, 2006 under 37 CFR 1.131 have been considered but are ineffective to overcome the Hartung et al. reference.

16. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Hartung reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). The Joint Declaration filed August 11, 2006, while describing events from Spring of 1992 onward, fails to present any proof of the inventive act prior to July of 1994, there being no demonstrative evidence or a complete disclosure to another.

Conclusion

17. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,630,363 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

Applicant is reminded to file a Supplemental Reissue Oath/Declaration in accordance with 37 C.F.R. 1.175(b)(1) to state that every error not covered by a previous oath/declaration arose without deceptive intention on the part of the applicant. See M.P.E.P. 1414.01, 1444.

Applicant is notified that any subsequent amendment to the claims must comply with 37 CFR 1.173(c) by providing an explanation of the specific support in the disclosure of the patent for changes made to the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D. Zimmerman whose telephone number is 571-272-2749. The examiner can normally be reached on M-R 8:30A - 6:00P, Alternate Fridays 8:30A-5:00P.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on 571-272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joshua D Zimmerman
Examiner
Art Unit 2854

jdz


JUDY NGUYEN
SUPERVISORY PATENT EXAMINER